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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/717,048	11/18/2003	John B. Boyle	H0005274-4580	7455
23639	7590	09/26/2005		
BINGHAM, MCCUTCHEN LLP THREE EMBARCADERO CENTER 18 FLOOR SAN FRANCISCO, CA 94111-4067				EXAMINER
				BOYKIN, TERESSA M
			ART UNIT	PAPER NUMBER
			1711	

DATE MAILED: 09/26/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>
	10/717,048	BOYLE ET AL.
	<b>Examiner</b>	<b>Art Unit</b>
	Terressa M. Boykin	1711

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 19 September 2005.
- 2a) This action is FINAL.                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-43 is/are pending in the application.
  - 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1-43 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 18 November 2003 is/are: a) accepted or b) objected to by the Examiner.
 

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
  - a) All    b) Some \* c) None of:
    1. Certified copies of the priority documents have been received.
    2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
    3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

1) <input type="checkbox"/> Notice of References Cited (PTO-892)	4) <input type="checkbox"/> Interview Summary (PTO-413)
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)	Paper No(s)/Mail Date. _____
3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date <u>4-25-05</u> .	5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)
	6) <input type="checkbox"/> Other: _____

**35 U.S.C. 112, First Paragraph**

Claims 1- 43 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for the broadly defined "constituent" The specification on page 8 specifically disclose the constituent must individually or both combined be "*capable of being used as a fiber material....*" Thus, since the term 'constituent" when used alone is not limited to such use. i.e. the term constituent itself is understood to the skilled artisan as an ingredient, element or component, the term fiber constituent is broader than the enabling disclosure.

Although the CCPA has criticized the use of the characterization "too broad" or "undue breadth"....however, an application whose claim(s) are of a breadth which are not adequately supported by its specification is in violation of 35 USC 112, first paragraph. In re Borkowski et al., (CCPA 1970) 424 F2d 904; In re Wakefield, (CCPA 1970) 422 F2d 897; In re Hammack, (CCPA 197).

**Double Patenting**

**Claim 42 is rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 1 of copending Application No. 1-716584.**

Although the conflicting claims are not identical, they are not patentably distinct from each other because the pre-fiber composition which is used to make a spun fiber is formed using the same method as claimed and thus would inherently produce the

viscosity and cohesiveness as claimed the copending application. Any properties or characteristics inherent in the prior art, e.g. viscosity and cohesiveness, although unobserved or detected by the reference, would still anticipate the claimed invention.

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

**Claims 1-43 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 1 of copending Application No. 1-716584.**

As noted above, the pre-fiber composition which is used to make a spun fiber is formed using the same method as claimed and thus would obviously produce the viscosity and cohesiveness as claimed the copending application.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Art Unit: 1711

### **Claim Rejections - 35 USC § 102**

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United

**Claims 3-19, 23-43 are rejected under 35 U.S.C. 102(b, or e) as being anticipated by USP 5047459 see col. 2 through col. 5 claims 1-10 and ex. 1-28; or USPub 2002099136 see pages 1-3, paragraph 10 and 40, claims 1-9; or GB 2274109 see abstract, pages 2-4 and claims 1-6; or US 4745143 see cols. 1-5; or GB 1476997 see abstract, page 1 to page 2, claims 1-11 and ex.1.**

**USP 5047459** discloses a self-extinguishing thermoplastic composition comprising a polycondensate selected from the group consisting of thermoplastic processible polyamides, thermoplastic processible polyesters and a mixture thereof and a flame retardant which comprises a mixture of melamine with at least one adduct of .epsilon.-caprolactam and hexamethylene diisocyanate in a molar ratio of 0.2 to 0.5 mole of hexamethylene diisocyanate to 1 mole of .epsilon.-caprolactam, wherein the proportion of the adduct, based on the mixture of the melamine and adduct, amounts to 5-25% by weight of the flame retardant.

**USPub 2002099136** discloses a polyamide resin composition having an excellent gasoline resistance and impact resistance at a low temperature, and more particularly, to the polyamide resin composition comprising a general polyamide resin as an active ingredient; an impact modifier for dispersion such as EPM (ethylene/propylene) rubber, EPR (ethylene/propylene rubber) and EPDM (ethylene/propylene/diene) rubber; a plasticizer for providing flexibility such as lactams and sulfonamides; a thickener for uniform processability; and an ionomer for improving the appearance, elongation and impact strength, thus exhibiting advantages over conventional polyamide resins reinforced with an elastomer in excellent flexibility and appearance; superior gasoline resistance

and impact resistance at a low temperature; better price as compared to its functions and thus enabling to be used in fuel tube systems of an automobile.

**GB2274109** discloses molding composition for easier molding -containing. nylon, magnesium hydroxide flame-retardant and caprolactam! for reduced surface defects of moldings.

**US 4745143** discloses a salt resistant composition comprising a polyamide selected from the group consisting of: polyepsiloncaprolactam, polyhexamethylene adipamide; copolymers of caprolactam, hexamethylene diamine, and adipic acid; and mixtures thereof. The composition contains from 2 to 30 percent, and preferably 4 to 30 percent based on the weight of the polyamide of a water insoluble plasticizer, and a copolymer of an alpha-olefin and an unsaturated carboxylic acid and derivatives thereof. The plasticizer has been found to enable the polyamide composition to maintain its flexibility upon exposure to a variety of salts. Preferred plasticizers include lauryl lactam and sulfonamides. Preferred are sulfonamide type plasticizers such as n-ethyl o,p-toluenesulfonamide; o,p-toluene sulfonamide, and toluene sulfonamide formaldehyde resin. The invention includes articles made from the composition.

**GB1476997** discloses molding composition of polymers reinforced with mineral fillers.

Each of the references discloses a composition prepared from the same components as claimed by applicants. In view of the above, there appears to be no significant difference between the reference(s) and that which is claimed by applicant(s). Any differences not specifically mentioned appear to be conventional. Consequently, the claimed invention cannot be deemed as novel and accordingly is unpatentable.

### Correspondence

Please note that the cited U.S. patents and patent application publications are available for download via the Office's PAIR. As an alternate source, all U.S. patents and patent application publications are available on the USPTO web site ([www.uspto.gov](http://www.uspto.gov) <<http://www.uspto.gov>>), from the Office of Public Records and from commercial sources. Applicants may be referred to the Electronic Business Center (EBC) at <<http://www.uspto.gov/ebc/index.html>> or 1-866-217-9197.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Examiner Terressa Boykin whose telephone number is

571 272-1069. The examiner can normally be reached on Monday through Friday from 6:30am to 3:00pm.

The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306. The general information number for listings of personnel is (**571-272-1700**).

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

tmb

  
Examiner Terressa Boykin  
Primary Examiner  
Art Unit 1711